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EXAMINER

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ART UNIT	PAPER NUMBER
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2622

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/277,172

Applicant(s)

MAEDA, TORU

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) 23-26 and 75-88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 27-74 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 & 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. **Claims 1-22 and 27-74**, drawn to an apparatus which detects a function during communication in G3 communication, and disconnects and shifts to an Internet facsimile communication based on the detection, classified in class 358, subclass 1.15.
 - II. **Claims 23-26, and 75-88**, drawn to an apparatus that notifies an apparatus that it has an Internet facsimile function, and that notifies the apparatus of an internet facsimile address, both during communication in a G3 facsimile mode, classified in class 358, subclass 439.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a system that switches from a G3 facsimile transmission mode to a Internet transmission mode, while invention II has separate utility such as a facsimile system that notifies capabilities and an internet address during G3 communication protocol. See MPEP § 806.05(d).
3. During a telephone conversation with Lock See Yu-Jahnes on Thursday, July 18, 2002, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-22 and 27-74. Affirmation of this election must be made by applicant in replying to this Office

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action. Claims 23-26, and 75-88 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

4. The references listed in the Information Disclosure Statements submitted on 11/3/99 and 3/20/01 have been considered by the examiner (see attached PTO-1449).

Drawings

5. The drawings are objected to because:
in Figs. 2 and 12, "Frame Mane" should read "Frame Name" in the top line;
in Figs. 2 and 12, "E-male" should read "E-mail" in each of the three listings under "Description";

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1 and 27** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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8. Regarding *claim 1*, the word "means" is preceded by the word(s) "G3 facsimile communication" in lines 3 and 4, and "Internet facsimile communication" in lines 7 and 8, in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. Regarding *claim 27*, the word "means" is preceded by the word(s) "Internet facsimile communication" in lines 7 and 8, in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-4, 7-15, 18-22, 27-30, 33, 34, 42-44, 52-55, 58, 59, and 66-68** are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada (U.S. Patent Number 5,521,719).

Regarding *claim 1*, Yamada discloses a communication apparatus comprising means for detecting a facsimile function of a communication partner's apparatus during communication by G3 facsimile communication means (column 7, line 63 through column 8, line 51, and column 14, lines 52 through 62), and means for performing control of causing the G3 facsimile communication means to disconnect communication in a G3 facsimile mode (column 18, line 59

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through column 19, line 60) and shifting to communication by Internet facsimile communication means (column 15, lines 8 through 25, and column 16, lines 16 through 33), based on the detection of the facsimile function of the communication partner's apparatus by the detection means (column 19, lines 1 through 60).

Regarding *claim 2*, Yamada discloses the apparatus discussed above in claim 1, and further teaches of means (image memory 125) for storing the function of the communication partner's apparatus (column 14, line 52 through column 15, line 25), wherein the control means stores the facsimile function of the communication partner's apparatus detected by the detection means in the storage means (column 14, lines 52 through 62), obtains the facsimile function of the communication partner's apparatus stored in the storage means from the storage means (column 14, lines 63 through column 15, line 25), and causes the Internet facsimile communication means to transmit image data in accordance with the obtained facsimile function of the communication partner's apparatus (column 15, lines 5 through 53, and column 19, lines 1 through 60).

Regarding *claim 3*, Yamada discloses the apparatus discussed above in claim 1, and further teaches that the G3 facsimile communication means transmits a signal indicating to which of Internet facsimile modes a mode is to be switched (column 7, line 63 through column 8, line 39, column 14, lines 52 through 62, and column 15, lines 8 through 25).

Regarding *claim 4*, Yamada discloses the apparatus discussed above in claim 1, and further teaches that the G3 facsimile communication means transmits a signal notifying an Internet address of the communication apparatus (column 15, lines 8 through 25).

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Regarding **claim 7**, Yamada discloses the apparatus discussed above in claim 4, and further teaches that the Internet address comprises an E-mail address (column 15, lines 8 through 25).

Regarding **claim 8**, Yamada discloses the apparatus discussed above in claim 1, and further teaches of a means for determining whether or not the communication is a first communication operation with the communication partner's apparatus by the Internet facsimile communication means (column 3, lines 55 through column 4, line 49, and column 14, line 63 through column 15, line 25), wherein the control means performs G3 facsimile communication before the communication by the Internet facsimile communication means (column 14, line 63 through column 15, line 25), based on determination that the communication is a first communication operation with the communication partner's apparatus by the Internet facsimile communication means (column 3, lines 55 through column 4, line 49, and column 14, line 63 through column 15, line 25), and causes the G3 facsimile communication means to disconnect the communication in the G3 facsimile mode (column 18, line 59 through column 19, line 60) and shifts to communication by the Internet facsimile communication means (column 15, lines 8 through 25, and column 16, lines 16 through 33), based on the detection of the facsimile function of the communication partner's apparatus by the detection means (column 19, lines 1 through 60), and performs control of image transmission by the Internet facsimile communication means in accordance with the facsimile function of the communication partner's apparatus (column 15, lines 20 through 53).

Regarding **claim 9**, Yamada discloses a communication apparatus comprising means for detecting a facsimile function of a communication partner's apparatus during communication by

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G3 facsimile communication means (column 7, line 63 through column 8, line 51, and column 14, lines 52 through 62), and means for causing Internet facsimile communication means to transmit an image in accordance with the facsimile function of the communication partner's apparatus detected by the detection means (column 15, lines 8 through 25, column 16, lines 16 through 33, and column 19, lines 1 through 60).

Regarding *claim 10*, Yamada discloses the apparatus discussed above in claim 9, and further teaches of means (image memory 125) for storing the function of the communication partner's apparatus (column 14, line 52 through column 15, line 25), wherein the control means stores the facsimile function of the communication partner's apparatus detected by the detection means in the storage means (column 14, lines 52 through 62), obtains the facsimile function of the communication partner's apparatus stored in the storage means from the storage means (column 14, lines 63 through column 15, line 25), and causes the Internet facsimile communication means to transmit image data in accordance with the obtained facsimile function of the communication partner's apparatus (column 15, lines 5 through 53, and column 19, lines 1 through 60).

Regarding *claim 11*, Yamada discloses the apparatus discussed above in claim 10, and further teaches of a means for determining whether or not the communication is a first communication operation with the communication partner's apparatus by the Internet facsimile communication means (column 3, lines 55 through column 4, line 49, and column 14, line 63 through column 15, line 25), wherein the control means causes the G3 facsimile communication means to transmit image data in a first communication operation (column 15, lines 5 through 53), based on determination by the determination means that the communication is a first

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communication operation with the communication partner's apparatus by the Internet facsimile communication means (column 14, line 63 through column 15, line 25), and causes the Internet facsimile communication means to transmit image data in accordance with the facsimile function of the communication partner's apparatus stored in the storage means (column 15, lines 8 through 25, and column 16, lines 16 through 33), based on determination by the determination means that the communication is not a first communication operation with the communication partner's apparatus by the Internet facsimile communication means (column 16, line 1 through column 17, line 52).

Regarding *claim 12*, Yamada discloses a communication method comprising the steps of detecting a facsimile function of a communication partner's apparatus during communication in a G3 facsimile communication mode (column 7, line 63 through column 8, line 51, and column 14, lines 52 through 62), disconnecting communication in the G3 facsimile mode based on the detection of the facsimile function of the communication partner's apparatus (column 18, line 59 through column 19, line 60), and shifting to communication in an Internet facsimile mode (column 15, lines 8 through 25, and column 16, lines 16 through 33).

Regarding *claim 13*, Yamada discloses the method discussed above in claim 12, and further teaches that the detected facsimile function of the communication partner's apparatus is stored (column 14, lines 52 through column 15, line 25), and wherein image data is transmitted in the Internet facsimile mode in accordance with the stored facsimile function of the communication partner's apparatus (column 15, lines 5 through 53, and column 19, lines 1 through 60).

Regarding *claim 14*, Yamada discloses the method discussed above in claim 12, and further teaches that when shifting from the G3 facsimile mode to the Internet facsimile mode, a signal indicating to which of Internet facsimile modes a mode is to be switched is transmitted (column 7, line 63 through column 8, line 39, column 14, lines 52 through 62, and column 15, lines 8 through 25).

Regarding *claim 15*, Yamada discloses the method discussed above in claim 12, and further teaches that a signal notifying an Internet address of a transmitter's apparatus is transmitted in the G3 facsimile mode (column 15, lines 8 through 25).

Regarding *claim 18*, Yamada discloses the method discussed above in claim 15, and further teaches that the Internet address comprises an E-mail address (column 15, lines 8 through 25).

Regarding *claim 19*, Yamada discloses the method discussed above in claim 12, and further teaches that it is determined whether or not the communication is a first communication operation in the Internet facsimile mode with the communication partner's apparatus (column 3, lines 55 through column 4, line 49, and column 14, line 63 through column 15, line 25), wherein G3 facsimile communication is performed before communication in the Internet facsimile mode (column 14, line 63 through column 15, line 25), based on determination that the communication is a first communication operation in the Internet facsimile mode with the communication partner's apparatus (column 3, lines 55 through column 4, line 49, and column 14, line 63 through column 15, line 25), and the communication in the G3 facsimile mode is disconnected (column 18, line 59 through column 19, line 60) and the communication shifts to communication in the Internet facsimile mode (column 15, lines 8 through 25, and column 16, lines 16 through

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33), based on the detection of the facsimile function of the communication partner's apparatus by the detection means (column 19, lines 1 through 60), and image transmission in the Internet facsimile mode is performed in accordance with the function of the communication partner's apparatus (column 15, lines 20 through 53).

Regarding **claim 20**, Yamada discloses a communication method having an Internet facsimile mode and a G3 facsimile mode (column 14, line 52 through column 15, line 25), with the method comprising the steps of detecting a facsimile function of a communication partner's apparatus during communication in the G3 facsimile mode (column 7, line 63 through column 8, line 51, and column 14, lines 52 through 62), and transmitting an image in the Internet facsimile mode in accordance with the detected facsimile function of the communication partner's apparatus (column 15, lines 8 through 25, column 16, lines 16 through 33, and column 19, lines 1 through 60).

Regarding **claim 21**, Yamada discloses the method discussed above in claim 20, and further teaches that the detected facsimile function of the communication partner's apparatus is stored (column 14, line 52 through column 15, line 25), and wherein image data is transmitted in the Internet facsimile mode in accordance with the stored facsimile function of the communication partner's apparatus (column 15, lines 5 through 53, and column 19, lines 1 through 60).

Regarding **claim 22**, Yamada discloses the method discussed above in claim 21, and further teaches that it is determined whether or not the communication is a first communication operation in the Internet facsimile mode with the communication partner's apparatus (column 3, lines 55 through column 4, line 49, and column 14, line 63 through column 15, line 25), wherein

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image data is transmitted in the G3 facsimile mode in a first communication operation (column 15, lines 5 through 53), based on determination that the communication is a first communication operation in the Internet facsimile mode with the communication partner's apparatus (column 14, line 63 through column 15, line 25), and wherein an image is transmitted in the Internet facsimile mode in accordance with the facsimile function of the communication partner's apparatus (column 15, lines 8 through 25, and column 16, lines 16 through 33), based on determination that the communication is not a first communication operation in the Internet facsimile mode with the communication partner's apparatus (column 16, line 1 through column 17, line 52).

Regarding *claim 27*, Yamada discloses a communication apparatus comprising means for detecting an Internet facsimile mode (column 15, lines 5 through 25, and column 19, lines 42 through 60) of a communication partner's apparatus during communication by G3 facsimile communication means (column 7, line 63 through column 8, line 51, and column 14, lines 52 through 62), and means for performing control of causing the G3 facsimile communication means to disconnect communication in a G3 facsimile mode (column 18, line 59 through column 19, line 60) and shifting to communication by Internet facsimile communication means (column 15, lines 8 through 25, and column 16, lines 16 through 33), based on the detection of Internet facsimile mode of the communication partner's apparatus by the detection means (column 19, lines 1 through 60).

Regarding *claim 28*, Yamada discloses the apparatus discussed above in claim 27, and further teaches of means (image memory 125) for storing a function of the communication partner's apparatus (column 14, line 52 through column 15, line 25), wherein the control means stores the Internet facsimile mode of the communication partner's apparatus detected by the

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detection means in the storage means (column 14, lines 52 through 62), obtains the Internet facsimile mode of the communication partner's apparatus stored in the storage means from the storage means (column 14, lines 63 through column 15, line 25), and causes the Internet facsimile communication means to transmit image data in accordance with the obtained Internet facsimile mode of the communication partner's apparatus (column 15, lines 5 through 53, and column 19, lines 1 through 60).

Regarding **claim 29**, Yamada discloses the apparatus discussed above in claim 27, and further teaches that the G3 facsimile communication means transmits a signal indicating to which of Internet facsimile modes a mode is to be switched (column 7, line 63 through column 8, line 39, column 14, lines 52 through 62, and column 15, lines 8 through 25).

Regarding **claim 30**, Yamada discloses the apparatus discussed above in claim 27, and further teaches that the G3 facsimile communication means transmits a signal notifying an Internet address of the communication apparatus (column 15, lines 8 through 25).

Regarding **claim 33**, Yamada discloses the apparatus discussed above in claim 30, and further teaches that the Internet address comprises an E-mail address (column 15, lines 8 through 25).

Regarding **claim 34**, Yamada discloses the apparatus discussed above in claim 27, and further teaches of a means for determining whether or not the communication is a first communication operation with the communication partner's apparatus by the Internet facsimile communication means (column 3, lines 55 through column 4, line 49, and column 14, line 63 through column 15, line 25), wherein the control means performs G3 facsimile communication before the communication by the Internet facsimile communication apparatus (column 14, line

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63 through column 15, line 25), based on determination that the communication is a first communication operation with the communication partner's apparatus by the Internet facsimile communication means (column 3, lines 55 through column 4, line 49, and column 14, line 63 through column 15, line 25), and causes the G3 facsimile communication means to disconnect the communication in the G3 facsimile mode (column 18, line 59 through column 19, line 60) and shifts to communication by the Internet facsimile communication means (column 15, lines 8 through 25, and column 16, lines 16 through 33), based on the detection of the facsimile function of the communication partner's apparatus by the detection means (column 19, lines 1 through 60), and performs control of image transmission by the Internet facsimile communication means in accordance with the facsimile function of the communication partner's apparatus (column 15, lines 20 through 53).

Regarding *claim 42*, Yamada discloses a communication apparatus comprising means for detecting an Internet facsimile mode (column 15, lines 5 through 25, and column 19, lines 42 through 60) of a communication partner's apparatus during communication by G3 facsimile communication means (column 7, line 63 through column 8, line 51, and column 14, lines 52 through 62), and means for causing Internet facsimile communication means to transmit an image in accordance with the Internet facsimile mode of the communication partner's apparatus detected by the detection means (column 15, lines 8 through 25, column 16, lines 16 through 33, and column 19, lines 1 through 60).

Regarding *claim 43*, Yamada discloses the apparatus discussed above in claim 42, and further teaches of means (image memory 125) for storing a function of the communication partner's apparatus (column 14, line 52 through column 15, line 25), wherein the control means

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stores the Internet facsimile mode of the communication partner's apparatus detected by the detection means in the storage means (column 14, lines 52 through 62), obtains the Internet facsimile mode of the communication partner's apparatus stored in the storage means from the storage means (column 14, lines 63 through column 15, line 25), and causes the Internet facsimile communication means to transmit image data in accordance with the obtained Internet facsimile mode of the communication partner's apparatus (column 15, lines 5 through 53, and column 19, lines 1 through 60).

Regarding *claim 44*, Yamada discloses the apparatus discussed above in claim 43, and further teaches of a means for determining whether or not the communication is a first communication operation with the communication partner's apparatus by the Internet facsimile communication means (column 3, lines 55 through column 4, line 49, and column 14, line 63 through column 15, line 25), wherein the control means causes the G3 facsimile communication means to transmit image data in a first communication operation (column 14, line 63 through column 15, line 25), based on determination by the determination means that the communication is a first communication operation with the communication partner's apparatus by the Internet facsimile communication means (column 3, lines 55 through column 4, line 49, and column 14, line 63 through column 15, line 25), and causes the Internet facsimile communication means to transmit image data in accordance with the Internet facsimile mode of the communication partner's apparatus stored in the storage means (column 15, lines 8 through 25, and column 16, lines 16 through 33, and column 18, line 59 through column 19, line 60), based on determination by the determination means that the communication is not a first communication operation with

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the communication partner's apparatus by the Internet facsimile communication means (column 16, line 1 through column 17, line 52).

Regarding **claim 52**, Yamada discloses a communication method comprising the steps of detecting an Internet facsimile mode (column 15, lines 5 through 25, and column 19, lines 42 through 60) of a communication partner's apparatus during communication in a G3 facsimile mode (column 7, line 63 through column 8, line 51, and column 14, lines 52 through 62), disconnecting the communication in the G3 facsimile mode (column 18, line 59 through column 19, line 60) and performing setting according to the detected Internet facsimile mode (column 15, lines 8 through 25, and column 16, lines 16 through 33) based on the detection of Internet facsimile mode of the communication partner's apparatus, and shifting to Internet communication (column 19, lines 1 through 60).

Regarding **claim 53**, Yamada discloses the method discussed above in claim 52, and further teaches that the detected Internet facsimile mode of the communication partner's apparatus is stored (column 14, line 52 through column 15, line 25), and wherein image data is transmitted in the Internet facsimile mode in accordance with the stored Internet facsimile mode of the communication partner's apparatus (column 15, lines 5 through 53, and column 19, lines 1 through 60).

Regarding **claim 54**, Yamada discloses the method discussed above in claim 52, and further teaches that when shifting from the G3 facsimile mode to the Internet facsimile mode, a signal indicating to which of Internet facsimile modes a mode is to be switched is transmitted (column 7, line 63 through column 8, line 39, column 14, lines 52 through 62, and column 15, lines 8 through 25).

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Regarding *claim 55*, Yamada discloses the method discussed above in claim 52, and further teaches that a signal notifying an Internet address of a transmitter's apparatus is transmitted in the G3 facsimile mode (column 15, lines 8 through 25).

Regarding *claim 58*, Yamada discloses the method discussed above in claim 55, and further teaches that the Internet address comprises an E-mail address (column 15, lines 8 through 25).

Regarding *claim 59*, Yamada discloses the method discussed above in claim 52, and further teaches that it is determined whether or not the communication is a first communication operation in the Internet facsimile mode with the communication partner's apparatus (column 3, lines 55 through column 4, line 49, and column 14, line 63 through column 15, line 25), wherein G3 facsimile communication is performed before communication in the Internet facsimile mode (column 14, line 63 through column 15, line 25), based on determination that the communication is a first communication operation in the Internet facsimile mode with the communication partner's apparatus (column 3, lines 55 through column 4, line 49, and column 14, line 63 through column 15, line 25), and the communication in the G3 facsimile mode is disconnected (column 18, line 59 through column 19, line 60) and the communication shifts to communication in the Internet facsimile mode (column 15, lines 8 through 25, and column 16, lines 16 through 33), based on the detection of the Internet facsimile mode of the communication partner's apparatus (column 19, lines 1 through 60), and image transmission in the Internet facsimile mode is performed in accordance with the Internet facsimile mode of the communication partner's apparatus (column 15, lines 20 through 53).

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Regarding **claim 66**, Yamada discloses an image communication method having an Internet facsimile mode and a G3 facsimile mode (column 14, line 52 through column 15, line 25, and column 19, lines 42 through 60), with the method comprising the steps of detecting an Internet facsimile mode (column 15, lines 5 through 25, and column 19, lines 42 through 60) of a communication partner's apparatus during communication in the G3 facsimile mode (column 7, line 63 through column 8, line 51, and column 14, lines 52 through 62), and transmitting an image in the Internet facsimile mode in accordance with the detected Internet facsimile mode of the communication partner's apparatus (column 15, lines 8 through 25, column 16, lines 16 through 33, and column 19, lines 1 through 60).

Regarding **claim 67**, Yamada discloses the method discussed above in claim 66, and further teaches that the detected Internet facsimile mode of the communication partner's apparatus is stored (column 14, line 52 through column 15, line 25), wherein image data is transmitted in the Internet facsimile mode in accordance with the stored Internet facsimile mode of the communication partner's apparatus (column 15, lines 5 through 53, and column 19, lines 1 through 60).

Regarding **claim 68**, Yamada discloses the method discussed above in claim 67, and further teaches that it is determined whether or not the communication is a first communication operation in the Internet facsimile mode with the communication partner's apparatus (column 3, lines 55 through column 4, line 49, and column 14, line 63 through column 15, line 25), wherein image data is transmitted in the G3 facsimile mode in a first communication operation (column 15, lines 5 through 53), based on determination that the communication is a first communication operation in the Internet facsimile mode with the communication partner's apparatus (column 14,

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line 63 through column 15, line 25), and image data is transmitted in the Internet facsimile mode in accordance with the facsimile function of the communication partner's apparatus (column 15, lines 8 through 25, and column 16, lines 16 through 33), based on determination that the communication is not a first communication operation in the Internet facsimile mode with the communication partner's apparatus (column 16, line 1 through column 17, line 52).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 5, 6, 16, 17, 31, 32, 56, and 57** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (U.S. Patent Number 5,521,719) in view of Okutomi *et al.* (U.S. Patent Number 6,211,972).

Regarding **claims 5, 16, 31, and 56**, Yamada discloses the apparatuses and methods discussed above in claims 2, 13, 28, and 53, respectively, and further teaches that the Internet facsimile communication means comprises means for transmitting an E-mail (column 15, lines 20 through 25, and column 16, lines 28 through 33), means for converting a read image into an image file (column 13, lines 18 through 24), and wherein the control means stores a DIS signal received by the G3 facsimile communication means in the storage means so as to correspond to an Internet facsimile address of the communication partner's apparatus (column 8, lines 5

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through 11, and column 18, lines 47 through 51), and causes the conversion means to convert the read image into the image file in accordance with the DIS signal stored in the storage means, during image transmission by the Internet facsimile communication means (column 18, lines 47 through 58).

However, Yamada fails to particularly teach of an addition means for adding the image file to the E-mail. Okutomi discloses a communication apparatus comprising means for detecting a facsimile function of a communication partner's apparatus during communication by facsimile communication means (column 3, lines 33 through 52), and means for performing control of causing the facsimile communication means to disconnect communication in a facsimile mode (column 3, lines 49 through 63) and shifting to communication by Internet facsimile communication means (column 3, line 19 through column 4, line 12), based on the detection of the facsimile function of the communication partner's apparatus by the detection means (column 3, lines 40 through 52). Okutomi further teaches that the Internet facsimile communication means comprises means for transmitting an E-mail (LAN controlling section 7, seen in Fig. 3, and column 3, lines 19 through 25), means for converting a read image into an image file (e-mail format converting means 8, column 3, lines 19 through 25), and an addition means for adding the image file to the E-mail (column 5, lines 31 through 43), and wherein the control means stores a signal received by the facsimile communication means in the storage means so as to correspond to an Internet facsimile address of the communication partner's apparatus (column 3, lines 40 through 58), and causes the conversion means to convert the read image into the image file in accordance with the signal stored in the storage means, during image transmission by the Internet facsimile communication means (column 3, lines 49 through 63). Therefore, it would have been

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obvious to a person of ordinary skill in the art at the time the invention was made to include Okutomi's teachings in the system of Yamada. Yamada's system would easily be modified to include Okutomi's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claims 6, 17, 32, and 57*, Yamada and Okutomi disclose the apparatuses and methods discussed above in claims 5, 16, 31, and 56, respectively, and Okutomi further teaches that the image file comprises a TIFF file (column 3, lines 59 through 63, and column 5, lines 31 through 43). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Okutomi's teachings in the system of Yamada. Yamada's system would easily be modified to include Okutomi's teachings, as the systems share cumulative features, being additive in nature.

13. **Claims 35-39, 45-49, 60-64, and 69-72** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (U.S. Patent Number 5,521,719) in view of Feder (U.S. Patent Number 5,872,845).

Regarding *claims 35, 45, 60, and 69*, Yamada discloses the apparatuses and methods discussed above in claims 27, 42, 52, and 66, but fails to particularly teach if the plurality of Internet facsimile modes comprise a simple mode, a full mode, and a real time mode. Feder discloses a communication apparatus comprising means for detecting an Internet facsimile mode (column 1, lines 49 through 58) of a communication partner's apparatus during communication by G3 facsimile communication means (column 1, lines 49 through 58, column 6, lines 3 through 24, and column 7, lines 44 through 54), and means for performing control of causing the G3

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facsimile communication means to disconnect communication in a G3 facsimile mode (see Fig. 8B, column 9, lines 1 through 13) and shifting to communication by Internet facsimile communication means (see Fig. 8B, “yes” determination of “long distance call”, leading to process shown in Fig. 8C, column 8, lines 24 through 67), based on the detection of Internet facsimile mode of the communication partner’s apparatus by the detection means (column 9, lines 14 through 32). Feder further teaches of the plurality of Internet facsimile modes comprise a simple mode (column 7, lines 55 through 57), a full mode (column 5, lines 51 through 66), and a real time mode (column 7, lines 64 through 67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Feder’s teachings in the system of Yamada’s. Yamada’s system would easily be modified to include Feder’s teachings, as the systems share cumulative features, being additive in nature.

Regarding *claims 36, 46, 61, and 70*, Yamada and Feder disclose the apparatuses and methods discussed above in claims 35, 45, 60, and 69, respectively, and Feder further teaches that when shifting to the Internet facsimile mode, the control means selects one of the simple mode, the full mode, and the real time mode from among the Internet facsimile modes possessed by the communication partner’s apparatus according to a predetermined priority (column 7, lines 55 through 67, being the predetermined memory threshold level), and causes the Internet facsimile communication means to perform communication in the selected mode (column 7, line 55 through column 8, line 36). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Feder’s teachings in the system of Yamada’s. Yamada’s system would easily be modified to include Feder’s teachings, as the systems share cumulative features, being additive in nature.

Regarding *claims 37, 47, 62, and 71*, Yamada and Feder disclose the apparatuses and methods discussed above in claims 35, 45, 61, and 70, respectively, and Feder further teaches that the control means performs the selection in the order of the real time mode (column 7, lines 64 through 67), the full mode (column 5, lines 57 through 66), and the simple mode (column 55 through 64, wherein the selection depends on design choice of the user, and the amount of memory that the device has). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Feder's teachings in the system of Yamada's. Yamada's system would easily be modified to include Feder's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claims 38, 48, and 63*, Yamada and Feder disclose the apparatuses and method discussed above in claims 35, 45, and 61, respectively, and Feder further teaches that the control means performs the selection order of the full mode (column 5, lines 57 through 66), the real time mode (column 7, lines 64 through 67), and the simple mode (column 55 through 64, wherein the selection depends on design choice of the user, and the amount of memory that the device has). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Feder's teachings in the system of Yamada's. Yamada's system would easily be modified to include Feder's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claims 39, 49, 64, and 72*, Yamada and Feder disclose the apparatuses and methods discussed above in claims 35, 45, 61, and 70, respectively, and Feder further teaches that the Internet facsimile communication means comprises means for transmitting an e-mail (column 8, lines 37 through 67, and column 11, line 60 through column 12, line 14), means for

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converting a read image into an image file (column 6, lines 25 through 40), and means for adding the image file to the e-mail (column 6, lines 33 through 40, column 8, lines 37 through 52, and column 11, line 60 through column 12, line 14), and wherein, when the simple mode or the full mode of Internet facsimile has been selected (column 7, lines 55 through 64), the control means causes the Internet facsimile communication means to transmit the e-mail where an image file formed in accordance with each mode is added (column 7, line 55 through column 8, line 36). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Feder's teachings in the system of Yamada's. Yamada's system would easily be modified to include Feder's teachings, as the systems share cumulative features, being additive in nature.

14. **Claims 40, 50, and 73** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (U.S. Patent Number 5,521,719) in view of Feder (U.S. Patent Number 5,872,845), and further in view of Okutomi *et al.* (U.S. Patent Number 6,211,972).

Regarding **claims 40, 50, and 73**, Yamada and Feder disclose the apparatuses and method discussed above in claims 39, 49, and 72, respectively, and Yamada further teaches that the Internet address comprises an e-mail address (column 15, lines 8 through 25, seen in Fig. 11). However, both Yamada and Feder fail to particularly teach if the image file comprises a TIFF file. Okutomi discloses a communication apparatus having an Internet facsimile communication means that comprises means for transmitting an E-mail (LAN controlling section 7, seen in Fig. 3, and column 3, lines 19 through 25), means for converting a read image into an image file (e-

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mail format converting means 8, column 3, lines 19 through 25), and an addition means for adding the image file to the E-mail (column 5, lines 31 through 43), and wherein the control means stores a signal received by the facsimile communication means in the storage means so as to correspond to an Internet facsimile address of the communication partner's apparatus (column 3, lines 40 through 58), and causes the conversion means to convert the read image into the image file in accordance with the signal stored in the storage means, during image transmission by the Internet facsimile communication means (column 3, lines 49 through 63). Okutomi further teaches that the image file comprises a TIFF file (column 3, lines 59 through 63, and column 5, lines 31 through 43). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Okutomi's teachings in the system of Yamada and Feder. Yamada and Feder's system would easily be modified to include Okutomi's teachings, as the systems share cumulative features, being additive in nature.

15. **Claims 41, 51, 65, and 74** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (U.S. Patent Number 5,521,719) in view of Feder (U.S. Patent Number 5,872,845), and further in view of Kulakowski (WIPO Publication Number WO 97/10668, cited in the Information Disclosure Statement dated 3/20/01).

Regarding *claims 41, 51, 65, and 74*, Yamada and Feder disclose the apparatuses and methods discussed above in claims 35, 45, 61, and 70, respectively, and Feder further teaches that the Internet facsimile communication means comprises means for transmitting packets to an Internet address (column 8, lines 37 through 67, and column 9, lines 14 through 32), means for

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receiving packets (column 9, lines 33 through 65), means for converting a facsimile frame into packets (column 8, lines 24 through 67), and means for converting packets into a facsimile frame (column 9, line 53 through column 10, line 25), and wherein, when the real time mode has been selected (column 7, lines 64 through 67), the control means causes the Internet facsimile communication means to convert a procedure signal and image data into packets (column 8, lines 17 through 67), transmit the obtained packets according to a facsimile procedure (column 9, line 53 through column 10, line 25), and convert packets received from the communication partner's apparatus into a facsimile frame (column 9, line 65 through column 10, line 25).

However, Feder fails to particularly teach of means for converting a T30 frame into TCP packets, and means for converting TCP packets into a T30 frame, and subsequently, transmit the obtained TCP packets according to a T30 facsimile procedure, and convert TCP packets received from the communication partner's apparatus into a T30 frame. Kulakowski discloses a communication apparatus having an Internet facsimile communication means comprises means for transmitting TCP packets to an Internet address (page 13, lines 11 through 36, and page 14, lines 20 through 36), means for receiving TCP packets (page 20, lines 24 through 30), means for converting a T30 frame into TCP packets (page 14, lines 20 through 36, and page 16, line 28 through page 17, line 19), and means for converting TCP packets into a T30 frame (page 20, line 27 through page 21, line 7), and wherein the control means causes the Internet facsimile communication means to convert a procedure signal and image data into TCP packets, transmit the obtained TCP packets according to a T30 facsimile procedure, and convert TCP packets received from the communication partner's apparatus into a T30 frame (see Figs. 5, 7, and 8).

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's teachings in the system of Yamada and Feder. The system of Yamada and Feder would easily be modified too include Kulakowski's teachings, therein conforming to standards well known in the art, as the systems share cumulative features, being additive in nature.

Citation of Pertinent Prior Art

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Mori (U.S. Patent Number 6,384,927) discloses an Internet facsimile machine;

Ishibashi et al. (U.S. Patent Number 6,374,291) discloses a system of transmitting a facsimile message over the Internet; and

Kanaya (U.S. Patent Number 6,137,597) discloses a system for controlling an Internet facsimile apparatus.


Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

jrj
July 26, 2002

J.R.P.
Joseph R. Pokrzywa
Examiner
Art Unit 2622

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